

REMARKS/ARGUMENTS

Claims 4-6 are pending in the present application and are all presently rejected. The Applicants request reconsideration of the rejections in light of the following remarks.

Claims 4-6 of were rejected under 35 U.S.C. §103(a) as being unpatentable over *Rogers* (U.S. Pat. No. 5,617,471) in view of *Shaffer* (U.S. Pat. No. 5,825,858). The Applicants respectfully traverse this rejection for the following reasons.

Concerning independent claim 4, the prior art, alone or in combination, fails to teach the claimed element of "initiating setup, via the telecommunications switching office, and after reception of a request originating from the one of the further subscriber line and the operator's position, of a new direct telecommunications connection between the two subscriber lines wherein the telecommunications switching office requests one of two further telecommunications switching offices to which the two subscriber lines are respectively connected to set up the new telecommunications connection."

As argued previously, *Rogers* discloses a call transfer that is based on a first connection from a USER B (8) via a switch B (12) and a switch A (6) to a USER A (2) and a second connection between the USER A (2) via switch A (6) and a switch C (18) to a USER C (14) (see, e.g., FIGs. 1 and 7). The setup of the second connection from USER B to USER C (i.e., the removal or, respectively, release of the USER A), occurs such that a connection from USER B is set up via switch B, switch A, and switch C to USER C (see, e.g., FIG. 2 or FIG. 8). Thus, in general, *Rogers* is actually only teaching the setup of a connection between a CPE and a switch, such as a connection between USER A and switch A, as an example. Considering all the teachings of *Rogers* given in the disclosed examples, a call between the two connected users *always remains connected* via the switch A. The general summary disclosed in col. 2, lines 10-30, relied upon by the Examiner, confirms this point:

The call transfer by user-A is done by sending a message to the long distance carrier switching office (switch). In the switch, both independent calls are identified as part of the transfer request. At this point, the call transfer request is launched to the network control system (NCS) for the validation of the transfer. After NCS determines that the requested transfer is allowed, the call between users B and C is connected while user-A and user-A's CPE is disconnected from users B and C.

Furthermore, in the Response to Arguments, the Examiner addressed the aforementioned arguments by stating that "switch A is actually an 'operator' that actually determines how to bridge the call." No further argumentation was provided in this regard. First, Applicants respectfully request the Examiner to point out exactly what portions of the disclosure in *Rogers* support this statement. Second, it is respectfully requested that the Examiner provide further detail as to how this is relevant to the arguments submitted.

Rogers does not disclose the feature of "initiating setup. . . of a new direct telecommunications connection between the two subscriber lines. . ." Again, if the system of *Rogers* employed the claimed features of claim 4, the call transfer from the USER B to the USER C would be carried out such that a connection from the USER B would be set up via the switch B and the switch C to the USER C; i.e, without the use of switch A. This, however, is not the teaching or suggestion of *Rogers*. Nor is this element taught or suggested by *Shaffer*. Thus, this element is simply not met by the cited references, either combined or taken separately.

Additionally, the cited references do not teach or suggest the claimed feature of "set[ting] up the new telecommunications connection in accordance with a selection which is made as a function of a tariff model which forms a basis of a billing system."

As argued previously, using as an example the methodology of *Rogers*, if a subscriber B situated in the U.S., for example, called a subscriber A situated in Mexico and if subscriber B requested a transfer to a subscriber C in Canada, a connection would exist after the transfer from the subscriber B with switch B in the US to switch A in Mexico and from there to switch C with the subscriber C in Canada. The fees would correspond to the number of connections.

In contrast, using the above features of claim 4, a connection from the subscriber B would exist after the transfer with switch B in the U.S. to switch C with the subscriber C in Canada. Fees would only arise for the connection from B to C. Costs for the remote connection from B to A and from A to C would not arise contrary to the methodology of *Rogers* or *Shaffer*. Accordingly, the cited references do not teach or suggest all the elements of claim 4.

Furthermore, there is no teaching, suggestion or motivation to combine the references in the manner suggested in the Office Action. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (MPEP 2143). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (MPEP 2143.01). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2143).

In *Rogers*, a billing system is already disclosed, where a network call identifier uniquely identifies the call which is currently active or completed. Call detail records appear for call legs A-B 3, A-C 5, and B-C 7 on the customers' reports that accompany the invoices, so that the customers can readily identify the transferred calls (col. 7, line 65 – col. 8, line 24). In contrast, *Shaffer* relies on a unique conference bridge, utilizing a conference bridge manager that interfaces with the user interface, a connectivity computation component and a message interface component to tie in remote conference bridges (col. 4, lines 5-13; 30-39). As *Rogers* already provides for its own automated billing mechanism, there is no conceivable teaching, suggestion or motivation, other than one that was improperly gleaned from Applicant's disclosure, why one skilled in the art would turn to *Shaffer* to incorporate the conference bridge disclosed therein. As such, it is respectfully submitted that the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

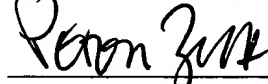
Concerning dependent claims 5 and 6, these claims are believed allowable on their merits and also on their dependency on claim 4.

In light of the above, the Applicants respectfully submit that claims 4-6 of the present application are patentable over the art of record. Therefore, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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